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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte AMY B. REED
and KAREN H. BEAN

Appeal 2008-4915
Application 09/976,411
Technology Center 1700

Decided: October 30, 2008

Before BRADLEY R. GARRIS, CHARLES F. WARREN, and
TERRY J. OWENS, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

DECISION ON APPEAL

Applicants appeal to the Board from the decision of the Primary Examiner finally rejecting claims 42 through 68 in the Office Action mailed March 14, 2007. 35 U.S.C. §§ 6 and 134(a) (2002); 37 C.F.R. § 41.31(a) (2007).

We affirm the decision of the Primary Examiner.

Claim 42 illustrates Appellants' invention of a medical packaging substrate, and is representative of the claims on appeal:

42. A medical packaging substrate comprising a paper-based web, the paper-based web being impregnated with a saturant comprising a latex polymer emulsion, the latex polymer emulsion comprising a polyacrylate having a glass transition temperature of -20°C or less, the saturant being present at an add-on level of from about 20 to about 80 dry parts per 100 dry parts of fiber in the paper-based web, wherein the medical packaging substrate exhibits a percent bacterial filtration efficiency of at least about 95%.

The Examiner relies upon the evidence in these references of record (Ans. 3):

Weber (Weber '734)	5,191,734	Mar. 9, 1993
Weber (Weber '132)	5,370,132	Dec. 6, 1994
E.W. Flick, Water-Soluble Resins – An Industrial Guide 163-81 (2nd, 1991).		

Appellants request review of the ground of rejection appealed claims 42 through 68 under 35 U.S.C. § 103(a) as unpatentable over Weber '734 in view of Flick, advanced on appeal by the Examiner. Br. 3; Ans. 3.

Appellants argue the claims as a group. Br. 3. Thus, we decide this appeal based on claim 42. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

The principal issue in this appeal is whether Appellants have shown the Examiner has not carried the burden of establishing a prima facie case of obviousness in the ground of rejection advanced on appeal, which turns on the issues addressed below.

The plain language of claim 42 specifies, in pertinent part, any medical packaging substrate comprising at least any paper-based web substrate impregnated with any saturant comprising at least a latex polymer emulsion comprising at least any polyacrylate having a glass transition

temperature (T_g) of -20°C or less. The paper-based web substrate must be impregnated with the polyacrylate containing saturant at an add-on level of from about 20 to about 80 dry parts per 100 dry parts of fiber in the paper-based web substrate, without limitation on the manner in which the substrate is impregnated. In this respect, Appellants disclose the paper-based web substrate is formed by applying the saturant to the substrate by processes involving spraying or dipping. Spec., e.g., 16:23-30. The impregnated paper-based web substrate must exhibit a percent bacterial filtration efficiency (BFE) of at least about 95%. This property can be determined by the disclosed protocol. Spec. 20:1-31. Appellants disclose that “after formation of the polymer-impregnated substrate, the fabric is then supplied to a maker of medical packaging.” Spec. 18:23-24.

We find Weber ‘734 would have disclosed to one of ordinary skill in this art a latex saturant impregnated paper-based web substrate which is useful for, among other things, surgical drapes. Weber ‘734, e.g., col. 1, ll. 5-16, and col. 2, ll. 33-57. “Most typically the latexes . . . will have a glass transition temperature (T_g) of between about -50° C. and about 20° C.,” and “[t]he saturant . . . when applied to the base web should have an add on from about 16 to about 80 dry parts saturant per 100 parts fiber by weight.” Weber ‘734, e.g., col. 2, ll. 58-66. Weber ‘734 illustrates polyacrylate latexes with, among other things, Hycar® 26120 and 26332. Weber ‘734, e.g., Table II and Example II. Weber ‘734 illustrates other latexes with, among other things, the polyethylene vinylacetate Dur-O-Set® E-669; the nitrile rubber Hycar® 1570 X 55; and the natural rubber Hartex® 104. Weber ‘734, e.g., Table II and Example I. The paper-based web “is

impregnated by directing the web through a bath of saturant containing the latex.” Weber ‘734 col. 5, ll. 35-37.

Weber ‘734 discloses the polyacrylate latex Hycar® 26332 has a Tg of -15° C, and the polyethylene vinylacetate Dur-O-Set® E-669 has a Tg of -20 °C. Weber ‘734 col. 6, ll. 44-47, and col. 7, ll. 51-52. Weber ‘132¹ would have disclosed the polyacrylate latex Hycar® 26120 has a Tg of -11° C; the nitrile rubber latex Hycar® 1570 X 55 has a Tg of -48° C; and the natural rubber latex Hartex® 104 has a Tg of - 70° C. Weber ‘132 Table IV.

Flick would have disclosed to one of ordinary skill in this art commercial water-soluble resins including, among others, the Hycar® acrylic latexes 25146 and 26171 with a respective Tg of -55°C and -43° C; and Hystretch® elastomeric latexes V-43, and V-29 with a respective Tg of -43° C and -29° C.

We determine the combined teachings of Weber ‘734 and Flick, the scope of which we determined above, provide sufficient evidence supporting the Examiner’s case that the claimed invention encompassed by claim 42, as we interpreted this claim above, would have been prima facie obviousness to one of ordinary skill in the coated web arts familiar with latex coatings for paper-based webs.

We agree with the Examiner that this person in routinely following the combined teachings of Weber ‘732 and Flick would have selected known polyacrylate latexes that have a Tg falling within the Tg range taught by

¹ The Examiner relies on Weber ‘132 solely for the Tg of latexes disclosed in Weber ‘732. Ans. 4.

Weber '732 in the reasonable expectation of obtaining saturants that can be used according to the processes of the reference to obtain impregnated paper-based web substrates that can be used for surgical drapes as disclosed by the reference. Ans. 3-4. This includes known polyacrylate latexes disclosed by Flick that have a Tg within the lower part of the Tg range of about -50° C and about 20° C taught by Weber '734 which overlaps the claimed Tg range of -20°C or less.

Accordingly, we are of the opinion that, prima facie, one of ordinary skill in this art routinely following the combined teachings of Weber '734 and Flick would have reasonably arrived at the claimed medical packaging substrate encompassed by claim 42, including all of the limitations thereof, without recourse to Appellants' Specification. *See, e.g., KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1739 (2007)(a patent claiming a combination of elements known in the prior art is obvious if the improvement is no more than the predictable use of the prior art elements according to their established functions); *In re Kahn*, 441 F.3d 977, 985-88, (Fed. Cir. 2006); *In re Keller*, 642 F.2d 413, 425 (CCPA 1981) (“[T]he test [for obviousness] is what the combined teachings of the references would have suggested to those of ordinary skill in the art.”); *In re Sovish*, 769 F.2d 738, 743 (Fed. Cir. 1985) (skill is presumed on the part of one of ordinary skill in the art); *see also In re O'Farrell*, 853 F.2d 894, 903-04 (Fed. Cir. 1988) (“For obviousness under § 103, all that is required is a reasonable expectation of success.” (citations omitted)).

We further agree with the Examiner that the claimed polyacrylate latex impregnated paper-based web substrate encompassed by claim 42

reasonably appears to be identical or substantially identical to the impregnated paper-based web substrate disclosed by the combined teachings of Weber '734 and Flick even though Weber '734 does not describe the property of a percent BFE of at least about 95%. Accordingly, the burden shifts to Appellants to patentably distinguish the claimed polyacrylate latex impregnated paper-based web substrate encompassed by claim 42 over that of the combined teachings of Weber '734 and Flick by effective argument and/or objective evidence even though the ground of rejection is under § 103(a). *See, e.g., In re Spada*, 911 F.2d 705, 708-09 (Fed. Cir. 1990) ("The Board held that the compositions claimed by Spada 'appear to be identical' to those described by Smith. While Spada criticizes the usage of the word 'appear,' we think that it was reasonable for the PTO to infer that the polymerization by both Smith and Spada of identical monomers, employing the same or similar polymerization techniques, would produce polymers having the identical composition."); *In re Best*, 562 F.2d 1252, 1255-56 (CCPA 1977) ("Where, as here, the claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes, the PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product. *See In re Ludtke*, [441 F.2d 660 (CCPA 1971)]."); *In re Skoner*, 517 F.2d 947, 950-51 (CCPA 1975) ("Appellants have chosen to describe their invention in terms of certain physical characteristics Merely choosing to describe their invention in this manner does not render patentable their method which is clearly obvious in view of [the reference]." (citation omitted)). In this respect, it is well

settled that the discovery of a new property or use of a product disclosed in the prior art does not confer patentability. *See, e.g., Spada*, 911 F.2d at 707, and cases cited therein.

Upon reconsideration of the record as a whole in light of Appellants' contentions, we are of the opinion that Appellants have not successfully shown that the Examiner has not carried the burden of establishing a prima facie case of obviousness. We disagree with Appellants' contention that the preamble phrase "medical packaging substrate" is "a limitation when read in the context of the present claims." Br. 5; *see also* 3-5. Indeed, on this record, we agree with the Examiner that "[t]he structure of the latex saturated paper described in the body of [claim 42] does not depend on the preamble phrase . . . for completeness" as the language "does not affect the structure of the claimed" polyacrylate latex impregnated paper-based web. Ans. 5. It is clear from the language of the body of claim 42 and the disclosure in the Specification that the claimed "substrate" is the impregnated paper-based web *per se*, and it is this substrate which Appellants intend to supply to a medical packaging manufacture. *See above* p. 3. Thus, on this record, the claimed impregnated paper-based web and the impregnated paper-based web of the combined teachings of Weber '734 and Flick are identical or substantially and both capable of functioning as a substrate for medical packaging as intended by Appellants and as surgical drapes as taught by Weber '734. *See, e.g., Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305 (Fed. Cir. 1999);² *Corning Glass Works*

² If the claim preamble, when read in the context of the entire

v. Sumitomo Elect. U.S.A., Inc., 868 F.2d 1251, 1257 (Fed. Cir. 1989); *In re Stencel*, 828 F.2d 751, 754-55 (Fed. Cir. 1987), and cases cited therein (“Whether a [statement] . . . of intended purpose constitutes a limitation to the claims is, as has long been established, a matter to be determined on the facts of each case in view of the claimed invention as a whole.”).

We further disagree with Appellants’ contentions that there is no indication the polyacrylate latex impregnated paper-based webs of Weber ‘734 and Flick would necessarily result in a percent BFE falling within the range claimed in claim 42, because “a variety of aspects [other than Tg] of the claimed medical packaging substrate may influence its % BFE, e.g., the add-on level, the type of web, and so forth.” Br. 7; *see also* 6-7. The difficulty with Appellants’ position is that there is no limitation in claim 42 with respect to the paper-based web which excludes paper-based webs of Weber ‘734, as, indeed, the claimed saturant add-on level range and Tg range overlap with that of the reference. Thus, the claimed impregnated paper-based web and that of Weber ‘734 and Flick reasonably appear

claim, recites limitations of the claim, or, if the claim preamble is ‘necessary to give life, meaning, and vitality’ to the claim, then the claim preamble should be construed as if in the balance of the claim If, however, the body of the claim fully and intrinsically sets forth the complete invention, including all of its limitations, and the preamble offers no distinct definition of any of the claimed invention’s limitations, but rather merely states, for example, the purpose or intended use of the invention, then the preamble is of no significance to claim construction because it cannot be said to constitute or explain a claim limitation.

Pitney Bowes, 182 F.3d at 1305.

identical or substantially identical even though a BFE range is not disclosed, and Appellants' arguments do not establish otherwise.

We also disagree with Appellants' contention that one of ordinary skill in the art would not have used a polyacrylate latexes within the claimed Tg range by Weber '734 because the reference does not disclose a specific polyacrylate latex within the claimed range, pointing out that Weber '734 discloses specific polyacrylate latexes having a Tg of -15°C or greater. Br. 7-10. It is clear that Weber '734 teaches one of ordinary skill in this art that a latex falling with the disclosed Tg range will work and thus, would have led this person to use other latexes of the kinds taught therein which fall within the Tg range, regardless of the extent of the latexes used to illustrate the Tg range in the reference. *See, e.g., In re Lamberti*, 545 F.2d 747, 750 (CCPA 1976) ("[T]he fact that a specific [embodiment] is taught to be preferred is not controlling, since all disclosures of the prior art, including unpreferred embodiments, must be considered."). Indeed, there is no disclosure in Weber '734 which would have suggested to this person that polyacrylate latexes are limited to the Tg range Appellants find in the reference. *Cf. In re Geisler*, 116 F.3d 1465, 1470 (Fed. Cir. 1997) ("The statement in Zehender that '[i]n general, the thickness of the protective layer should not be less than about [100 Angstroms]' falls far short of the kind of teaching that would discourage one of ordinary skill in the art from fabricating a protective layer of 100 Angstroms or less.").

Accordingly, based on our consideration of the totality of the record before us, we have weighed the evidence of obviousness found in the combined teachings of Weber '734 and Flick with Appellants'

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countervailing evidence of and argument for nonobviousness and conclude that the claimed invention encompassed by appealed claims 42 through 68 would have been obvious as a matter of law under 35 U.S.C. § 103(a).

The Primary Examiner's decision is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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